

Appl. No. 10/764,913  
Reply to Office Action of January 24, 2007

Attorney Docket No. 2003-0305 / 24061.516  
Customer No. 42717

#### REMARKS

Claims 1-37 are present in the application. In view of the remarks that follow, further and favorable consideration is respectfully requested.

#### Allowed Claims

Noted with appreciation is the indication in the Office Action that Claims 11-22 have been allowed.

#### Amendment to the Specification

A sentence appearing at line 10 on page 16 of the specification included an inadvertent typographical error. In particular, it incorrectly indicated that Figures 7-12 all depict a second embodiment. As evident from Figures 7-12 themselves, and from the sentence at lines 19-22 on page 18, Figures 7-12 actually disclose two different embodiments. One of these embodiments is shown in Figures 7-8, and the other is shown in Figures 9-12. MPEP §2163.06 explains that any part of a patent application may be amended to conform it to any other part. Accordingly, the foregoing amendments correct the typographical error that appeared in the sentence at line 10 on page 16, by amending that sentence so as to bring it into conformity with other portions of the application.

#### Election-Of-Species Requirement

In the most recent prior Office Action (mailed on October 11, 2006), the Examiner imposed an election-of-species requirement, between the species of Figure 2 and the species of Figure 7. Applicants then filed a prior Response (on November 7, 2007), which traversed the election-of-species requirement. In the present Office Action (mailed on January 24, 2007), the Examiner offers some brief comments in reply to Applicants' traverse, and then asserts that the election-of-species requirement is proper and is therefore made final. Based on this, Claims 23-35 have currently been withdrawn from examination on the merits. However, as

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discussed below, it is respectfully submitted that the comments offered by the Examiner make little sense. Accordingly, for reasons discussed below, Applicants again traverse the election-of-species requirement, including traverse of the comments offered by the Examiner in the present Office Action.

#### USE OF THE WORD "SECOND"

The Examiner's comments assert that Applicants' traverse relied on the doctrine that an applicant can be his or her own lexicographer. However, Applicants' traverse did not actually mention this particular doctrine, and in fact Applicants consider that doctrine to be irrelevant here. In particular, Applicants' traverse had nothing to do with an applicant's power to coin new terminology. To the contrary, Applicants' traverse discussed terminology coined by the Examiner in the October 11 Office Action, in particular with respect to references to a "second" plasma etch. In the present Office Action, the Examiner's discussion of how an applicant can be a lexicographer is out-of-place, has nothing to do with the issue at hand, and does nothing to justify the imposition of the election-of-species requirement.

A further problem relates to the fact that, while claims are the focus of a restriction requirement, claims are completely irrelevant in an election-of-species requirement, where the focus is species rather than claims. In this regard, as explained at lines 9-12 on page 3 of the Remarks in Applicants' last Response,

... MPEP §806.04(e) specifies that "*Claims are never species . . . Species are always the specifically different embodiments*". In an election-of-species requirement, Applicants' claims must be ignored, and the focus must be on the various different embodiments that are disclosed in the application.

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In contrast, in the present Office Action, the Examiner's discussion of the election-of-species requirement does not ignore the claims. The Examiner improperly focuses on the claims and discusses them at length, with repeated references to the claims. For example, in discussing the election-of-species requirement, the Examiner asserts that:

... the claim must apprise those ... looking at the patent [of] the scope of the claimed invention. In this instance, applicant has chosen to use the word second, which has general accepted meaning that denotes a particular order in a method claim. Because the word second has not been redefined, the claim is interpreted based on its plain and ordinary meaning. As such, when contrasting two claims that use a second etch step for different purposes, the word is no longer merely for convenience, but its use creates two distinct methods. (Emphasis added).

Since claims are completely irrelevant to an election-of-species requirement, and should be completely ignored, the Examiner's discussion of claims is completely out-of-place, and does nothing to justify the imposition of the election-of-species requirement. To the contrary, it tends to show that the present election-of-species requirement was based on faulty and improper reasoning.

In contrast, Applicant's traverse in the last Response properly focused on embodiments (i.e. species), while ignoring the claims. In particular, as Applicants' traverse correctly pointed out:

The embodiments of Figures 2 and 7 each use a plasma etch for trimming, and these embodiments are not distinct merely because the trimming etch in one embodiment is referred to for

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convenience [by the Examiner] as a "second" etch, while the trimming etch in another embodiment is referred to for convenience [by the Examiner] as a "first" or "third" or "fourth" etch. The Office Action merely raises a point of semantics, rather than any actual difference between the two species.

The Examiner's extended discussion of differences between claims is irrelevant, and offers nothing to refute Applicants' argument that the election-of-species requirement is not proper.

#### THE ELECTION-OF-SPECIES REQUIREMENT IS NOT COMPLETE

In traversing the election-of-species requirement, Applicants' last Response pointed out that the election requirement was not complete. In particular, the election requirement mentioned only the two embodiments that are respectively disclosed in Figure 2 and Figure 7 of the present application, and did not mention certain other disclosed embodiments. For example, in addition to the embodiments shown in Figures 2 and 7, the first paragraph on page 18 of the specification discusses yet another embodiment, and the paragraph bridging pages 18-19 explains that Figure 9 discloses still another embodiment. In the present Office Action, the comments offered by the Examiner refer to a sentence that appeared in line 10 on page 16 of Applicants' specification, and that suggested Figures 7-12 all show one embodiment. However, as discussed above, this sentence included an inadvertent typographical error, and the foregoing amendments to the specification correct this inadvertent error. Contrary to the assertions in the Office Action, Figures 7-12 shown two different embodiments. In particular, Figures 7-8 show one embodiment, and Figures 9-12 show a different embodiment. Consequently, as correctly pointed out in Applicants' last Response, the embodiment in Figures 9-12 was improperly excluded from the election-of-species requirement. The Examiner does not have the right to structure an election-of-species requirement in a manner so that it is impossible for Applicants to elect certain

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disclosed embodiments that are encompassed by the claims (such as the embodiment of Figure 9). The present election-of-species requirement is therefore incomplete and defective, and Applicants again respectfully submit that it must be withdrawn.

Compliance With First Paragraph of 35 U.S.C. §112

In the paragraph bridging pages 3-4 of the Office Action, the Examiner rejects Claims 1-10 and 36-37 under the first paragraph of 35 U.S.C. §112, asserting that these claims are not enabled by the disclosure. More specifically, the Office Action notes that Claim 1 recites a bilayer stack, but that Claim 1 does not recite the bilayer stack is provided on a gate layer. The Office Action then goes on to assert that the absence of this limitation in Claim 1 means Claim 1 is not enabled by the specification, further asserting that Applicants' specification teaches it is critical or essential to the practice of the invention that the bilayer stack must be formed on a gate layer. In support of this theory, the Office Action asserts that the "specification at page 7 explicitly states that his objectives/invention of forming a gate is achieved by coating/forming of the bilayer on the gate layer". However, this is not what is taught at the indicated location on page 7 of the specification. More specifically, page 7 merely identifies some objects of the invention, but never states that they are the only objects, or that they are essential objects. Moreover, page 7 then discusses a technique that can meet stated objects, but never states that those objects or the technique are critical or essential to the practice of the invention. A further consideration is that, aside from a minor prior amendment to Claim 1 that deletes a lower case letter from the beginning of each subparagraph (without changing the scope of Claim 1), Claim 1 is an originally-filed claim, and the originally-filed claims are by definition a part of the specification. (MPEP §608.01(a); second paragraph of 35 U.S.C. §112). Consequently, in the original application papers, Claim 1 itself constitutes a definition of one form of the invention in which Applicants show that they did not consider it to be essential or critical to every form of the invention that a bilayer stack must be provided on a gate layer. There is no reasonable basis for

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the assertions to the contrary in the Office Action. Accordingly, it is respectfully submitted that this particular ground of rejection under §112 is without basis, and must be withdrawn.

In the first full paragraph on page 4 of the Office Action, the Examiner sets forth a second ground of rejection under §112. More specifically, the Examiner rejects Claims 1-10 and 36-37 under the first paragraph of 35 U.S.C. §112, asserting that these claims fail to comply with the enablement requirement, in particular based on an assertion that these claims recite subject matter that is not described in the specification. One defect with this ground of rejection is that the Office Action fails to identify any specific word or phrase in any of Claims 1-10 and 36-37 that is believed by the Examiner to be potentially problematic. This rejection is thus so vague as to be incomplete and defective.

For the sake of discussion, Applicants assume that the basis for this rejection is basically the same as that discussed in the preceding paragraph, namely that Claim 1 fails to specify the recited bilayer stack is formed on a gate layer. However, as explained above, Claim 1 is one of the originally-filed claims, and the originally-filed claims are by definition a part of the specification. Aside from a minor prior amendment to Claim 1 that deleted a lower case letter from the beginning of each subparagraph (without changing the scope of Claim 1), the current subject matter of Claim 1 is effectively the same as when Claim 1 was originally filed. Consequently, in the original application papers, Claim 1 provides its own enabling disclosure in the specification. There is no reasonable basis for the assertion in the Office Action that Applicants are claiming subject matter that is not properly enabled (especially since the first full paragraph on page 4 of the Office Action is vague and fails to identify any specific word or phrase in the claims that is supposedly not enabled by the originally-filed specification).

In the second full paragraph on page 4 of the Office Action, the Examiner sets forth a third ground of rejection under §112. In particular, the Examiner rejects Claims 1-10 and 36-37 under the first paragraph of 35 U.S.C. §112, asserting that "the specification, while being

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enabling for the narrow disclosure of making a gate for a semiconductor, . . . does not reasonably provide enablement for the wide breadth of claim 1". In support of this ground of rejection, the Examiner cites MPEP §2164.06(b). However, MPEP §2164.06(b) does not apply here, because it is expressly limited to "Drug Cases" and "Chemical Cases". In contrast, Claims 1-10 and 36-37 of the present application are not reciting a drug or a chemical reaction. As explained in MPEP §2164.03, when an invention is outside the chemical arts (as is the case here), the disclosure of a single species can support very broad claims. Accordingly, Applicants respectfully submit that the various species disclosed in the present application are more than adequate to support the broad scope of Claim 1. There is no reasonable basis for the assertions to the contrary in the Office Action. Accordingly, it is respectfully submitted that this particular ground of rejection under §112 is without basis.

For each of the various different reasons discussed above, it is respectfully submitted that Claims 1-10 and 36-37 are all properly supported by a disclosure that meets the enablement requirement of the first paragraph of §112. Notice to that effect is respectfully requested.

Claims 1-10 and 36-37 are rejected only under §112, and not in view of the prior art. Accordingly, since Claims 1-10 and 36-37 are believed to be in compliance with §112 (for the reasons discussed above), it is respectfully submitted that these claims are all in proper condition for allowance, and notice to that effect is respectfully requested.

#### Conclusion

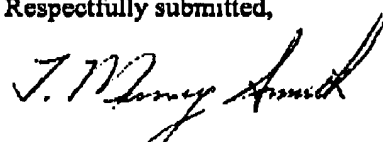
Further and favorable consideration of this application is respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

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Although Applicants believe that no fee is due in association with the filing of this paper, the Commissioner is hereby authorized to charge any fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



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Enclosures: None

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